

### REMARKS

Claims 1-5 and 7-17 are pending in this application, with claims 1, 12, and 16 being in independent form.

The sole issue remaining is the rejection of claims 1-5 and 7-17 under 35 U.S.C. § 101 as allegedly being directed to non-statutory subject matter.

Applicant submits that independent claims 1, 12, and 16 are clearly directed to statutory subject matter, for at least the following reasons.

The present invention as set forth in claim 1 is intended to provide members of the public with a portal providing access to a wide range of services, including use of a computer, printer, intranet, video conferencing, etc. In one non-limiting embodiment of the invention, members of the public can interact with a portal providing them with access to the internet, thereby enabling them to take advantage of the many benefits that the internet provides. By virtue of the features of the invention, many people, whether rich or poor, computer-literate or not, living in developed geographic areas or not, can be provided with easy access to all such computer- and internet- related services. Accordingly, the so-called “digital divide” can be narrowed.

Claim 1 is directed to a public-access e-commerce service portal, claim 12 is directed to a public-access e-commerce service network, and claim 16 is directed to a method of providing public access to e-commerce activities.

35 U.S.C. § 101 provides:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

At page 3 of the Office Action, the Examiner asserts, in connection with claim 1, that:

...the steps of “a computer including...”, “a video camera...”, “a telecommunications...”, and “a service unit...”, which comprise the claim as a whole are mere steps in the abstract without setting forth a practical application for producing any useful, concrete, and tangible result. (See Interim Guidelines, IV (C)(1,2)). (Emphasis added.)

At pages 2-3 of the Office Action the Examiner states:

For a claimed invention to be statutory, the claimed invention must produce a useful, concrete, and tangible result. Mere ideas in the abstract (i.e. abstract idea, law of nature, natural phenomena) that do not apply, invoice, or use fail to promote the “progress of science and the useful arts” (i.e., the physical sciences as opposed to social sciences, for example) and therefore are found to be non-statutory subject matter. For a process claim to pass muster, the recited process must somehow apply, involve, or use to produce a useful, concrete, or tangible result. (Emphasis added.)

The Examiner’s analysis thereby, at least in part, centers on the formulation of a “useful, concrete, and tangible result.” Applicant will proceed to address the claims according to this standard. However, Applicant also notes that on October 30, 2008, i.e., on the same day that the Examiner mailed the subject Office Action, the Federal Circuit decided *In Re Bilski*, \_\_\_ F.3d \_\_\_ (Fed. Cir. 2008) (en banc). In *Bilski*, the en banc panel found, at least with regard to claimed processes, that the “useful, concrete, and tangible result” formulation is “insufficient to determine whether a claim is patent-eligible under § 101”:

[W]e also conclude that the “useful, concrete and tangible result” inquiry is inadequate and reaffirm that the machine-or-transformation test outlined by the Supreme Court is the proper test to apply.

*Bilski* at 20.

Accordingly, *Bilski* adopted a test different from the “useful, concrete, and tangible” formulation, at least for process claims. The machine-or-transformation test was set out in *Bilski* as follows:

The Supreme Court ... has enunciated a definitive test to determine whether a process claim is tailored narrowly enough to encompass only a particular application of a fundamental principle rather than to pre-empt the principle itself. A claimed process is surely patent-eligible under § 101 if:  
(1) it is tied to a particular machine or apparatus, or  
(2) it transforms a particular article into a different state or thing.

*ID.* at 10. (Emphasis added.)

Of course, claims 1 and 12 are not processes, and, moreover, claims 1 and 12 encompass particular structures (e.g., a computer, a video camera, a telecommunications link, etc.) for performing the recited functions. Therefore, *Bilski* does not apply to claims 1 and 12.

Given all of the above, Applicant will first show that *all* of the claims produce a “useful, concrete, and tangible result.” Applicant will then proceed to apply the machine-or-transformation test set out in *Bilski* to process claim 16.

At page 3 of the Office Action, the Examiner states:

A mere intended or nominal use of a component does not confer statutory subject matter to an otherwise abstract idea if the component does not apply, involve, use, or advance the underlying process. Furthermore, the preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness, but, instead, the process steps or structural limitations are able to stand alone... In the instant case, the preamble of claim 1 recites “A system”. However, the claim as a whole recites the steps of intended use of a structure (i.e., system). Thus, the preamble fails to give “life, meaning, vitality” to the claim as a whole. See MPEP 2111.02. Because the preamble is not accorded any patentable weight as stated above, claim 1 as a whole merely recites steps in the abstract for use in a public access e-commerce service without producing any useful, concrete, and tangible result.

The preamble of claim 1 recites “a public-access e-commerce service portal providing a user access to the internet.” While Applicant does not concede the propriety of the

rejection, in order to facilitate allowance the body of claim 1 has been amended to specifically recite that the telecommunications link is “adapted to connect the computer to the internet, to thereby provide the user access to the internet.”

Under the *State Street* analysis, to meet the requirements of 35 U.S.C. § 101, “[t]he claimed invention as a whole must accomplish a practical application. That is, it must produce a ‘useful, concrete and tangible result.’” M.P.E.P. § 2106(II)(A) (quoting *State Street Bank & Trust v. Signature Financial Group, Inc.*, 149 F.3d 1368, 1373, 47 USPQ2d 1596, 1601 (Fed. Cir. 1998)). “The purpose of this requirement is to limit patent protection to inventions that possess a certain level of ‘real world’ value, as opposed to subject matter that represents nothing more than an idea or concept, or is simply a starting point for future investigation or research.” M.P.E.P. § 2106(II)(A) (quoting *Brenner v. Manson*, 383 U.S. 519, 528-36, 148 USPQ 689, 693-96 (1966); *In re Fisher*, 421 F.3d 1365, 76 USPQ2d 1225 (Fed. Cir. 2005); *In re Ziegler*, 992 F.2d 1197, 1200-03, 26 USPQ2d 1600, 1603-06 (Fed. Cir. 1993)) (Emphasis added).

The M.P.E.P. provides the following example of a claimed invention that produces a useful, concrete, and tangible result:

“[T]ransformation of data, representing discrete dollar amounts, by a machine through a series of mathematical calculations into a final share price, constitutes a practical application of a mathematical algorithm, formula, or calculation, because it produces ‘a useful, concrete and tangible result’ -- a final share price momentarily fixed for recording and reporting purposes and even accepted and relied upon by regulatory authorities and in subsequent trades.” *State Street*, 149 F.3d at 1373, 47 USPQ2d at 1601. M.P.E.P. § 2106(II)(A).

Claim 1 recites a public-access e-commerce service portal. The claim includes a telecommunications link adapted to connect the computer to the internet to thereby provide the user access to the internet. The claim also includes permitting the user to selectively

operate units such as a printer unit after login, and units such as a video camera for video conferencing, etc. It is respectfully submitted that if “transformation of data. . .into a final share price” is statutory subject matter, then the claimed invention including, *inter alia*, providing a user access to the internet, permitting the user to selectively operate units such as a printer unit after login and to operate units such as a video camera for video conferencing produces a “useful, concrete and tangible result”, i.e., a public-access e-commerce service portal providing services to a user.

As M.P.E.P. § 2106.IV makes clear, “[t]he subject matter courts have found to be outside of, or exceptions to, the four statutory categories of invention is limited to abstract ideas, laws of nature, and natural phenomena” (emphasis added). Since the claimed invention relates to a public-access e-commerce service portal, the court’s decision in *In re Alappat*, 33 F.3d 1526 (Fed. Cir. 1994), where the court first used the “useful, concrete, and tangible” language, is particularly instructive. In that case, the court considered whether Alappat’s invention, which related generally to a means for creating a smooth waveform display in a digital oscilloscope, was statutory under 35 U.S.C. § 101. In its analysis the court considered whether Alappat’s invention was an abstract idea; that is, the court first noted, as described above, that “there are three categories of subject matter for which one may not obtain patent protection, namely ‘laws of nature, natural phenomena, and abstract ideas.’” The court considered whether Alappat’s claimed invention was statutory:

Although many, or arguably even all, of the means elements recited in claim 15 represent circuitry elements that perform mathematical calculations, which is essentially true of all digital electrical circuits, the claimed invention as a whole is directed to a combination of interrelated elements which combine to form a machine for converting discrete waveform data samples into anti-aliased pixel illumination intensity data to be displayed on a display means. This is not a disembodied mathematical concept which may be characterized as an "abstract idea," but rather a specific machine to produce a useful, concrete, and tangible result. (Emphasis added.)

Therefore, the test applied by the *Alappat* court was whether the claimed invention, considered as a whole, represented nothing more than a law of nature, a natural phenomenon, or an abstract idea. The court found that something producing a useful, concrete, and tangible result is not an abstract idea. Accordingly, Applicant submits that her claimed invention as a whole, which is directed to a combination of interrelated elements which combine to form a machine for providing, e.g., public access to e-commerce services and the internet, is not an abstract idea, but, rather, is a specific machine to produce a useful, concrete, and tangible result.

In more detail, Applicant submits that a public-access e-commerce service portal, as recited in claim 1, including (1) a computer being programmed to permit a user to selectively operate units such as a printer unit, (2) a video camera connected to the computer to provide video-conference service to the user, (3) a telecommunications link adapted to connect the computer to an e-commerce intranet providing free services to the user and also being adapted to connect the computer to the internet to thereby provide the user access to the internet; and (4) a service unit including electric power and data connectors for use by a portable computing device, does not represent an abstract idea, natural phenomena, or an intellectual concept such as a mathematical algorithm. To the contrary, the features of claim

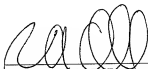
1 as a whole represent a “specific machine to produce a useful, concrete, and tangible result,” i.e., a public-access e-commerce service portal providing services to a user. This provides real-world value and produces a real-world result; for example, as noted above, by virtue of the features of claim 1, many people, whether rich or poor, computer-literate or not, living in developed geographic areas or not, can be provided with easy access to such computer- and internet- related services.

For at least the foregoing reasons, claim 1 is believed to be directed to statutory subject matter. Independent claims 12 and 16 are believed to be directed to statutory subject matter for similar reasons.

As to process claim 16 in particular, that claim now recites a method of providing public access to e-commerce activities through an e-commerce service portal including an information processing apparatus and a telecommunications link, and as such is at least seen to be tied to a particular machine or apparatus, thereby satisfying the *Bilski* test noted above.

In view of the foregoing remarks, Applicant respectfully requests favorable reconsideration and early passage to issue of the present application.

Respectfully Submitted

A handwritten signature in black ink, appearing to read 'Raymond A. DiPerna', is written over a horizontal line.

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